

REMARKS

Claims 1-5 and 10-26 are pending in this application. Claims 1-5 and 10-25 were rejected in the Final Office Action dated March 25, 2005. Claims 1-5 were rejected under 35 USC 103(a) as being unpatentable over Biddle (U.S. Patent Application Pub. No. 2002/0107809 A1) in view of Hayes (U.S. Patent Application Pub. No. 2001/0011341). Claims 10-25 were rejected under 35 USC 102(e) as anticipated by Biddle. Claim 26 was not rejected or otherwise considered in the Office Action. Reconsideration of all the pending claims is requested in light of the issues raised in the telephone interview on June 23, 2005 and additional arguments presented below.

Summary of Interview

In a phone interview between Examiner Firmin Backer and the undersigned attorney, the rejection of independent claims 1, 10 and 18 in the Office Action were discussed.

With respect to claim 18, it was pointed out that claim 18 was amended in the amendment dated December 2, 2004 but that the Office Action did not address the claim amendment or remarks made with respect to claim 18. The rejection of claim 18 in the Office Action was discussed. In particular, the element "the licensing module" was discussed with respect to possible elements in Biddle that could correspond to this claim element. The Examiner did not identify any element in Biddle having the limitations of this claim element. In particular a licensing module "comprising a portion of the software product that is customized for a distributor or a group of distributors" that is "stored at a first software distribution point so that it may be downloaded by a user" does not appear to be shown by Biddle.

With respect to claim 1, it was noted that the Office Action rejected this claim stating, "one of ordinary skill in the art would recognize that having access permission to download and having license to execute a program have the same technological meaning," Office Action, page 10, lines 18-20. This assertion was disputed and the differences between downloading and executing a program were discussed. It was

pointed out that Biddle, for example, shows downloading of a program without having a license to execute the program. Thus, the “licensing module” of claim 1 does not appear to be shown by Biddle.

With respect to claim 10, it was pointed out that the rejection of this claim in the Office Action appears contradictory. Claim 10 recites, “said distribution of one said program module is responsive to the prior execution of one said licensing module on one said customer terminal computer.” Biddle appears to disclose first downloading a software application then obtaining a license. The Office Action indicated disagreement with the characterization of Biddle as having the opposite order of downloading the program module and license module to that of claim 10. However, the text of the Office Action concerning claim 18 ends, “It may appear that in Biddle disclosure that the licensing module is downloaded after the application has been downloaded in the user computer. However, also disclose [sic] that the programming module is responsive prior to the execution of the licensing module which indicate that the licensing module is executed after a response from the program module,” Office Action, page 9, lines 18-22. This statement is not understood and, to the extent that it is understood, it appears contradictory. If, “the licensing module is executed after a response from the program module” as stated in the Office Action, it is not seen how this shows distribution of a program module responsive to prior execution of a licensing module.

With respect to claim 26, it was noted that the claim was not rejected or allowed or otherwise considered in the Office Action.

In response to the above issues, the Examiner indicated that a written submission should list the issues for consideration.

Additional Remarks

All pending claims are submitted to be allowable because claim elements of independent claims 1, 10 and 18 have not been shown in the prior art. The Office Action failed to show a license module of claim 1 in the prior art and did not provide any motivation to combine the cited references. Therefore, no *prima facie* case of obviousness was made with respect to claim 1. The Office Action did not show the license module and program module of claim 10 in the prior art and therefore failed to show that this

claim was anticipated. The Office Action did not address all the claim elements of claim 18 as amended and therefore failed to show that this claim was anticipated. These claim elements were not identified in the phone interview either. The Office Action did not address claim 26 at all. In addition, certain dependent claims contain additional elements that have not been shown.

It is submitted that the Office Action dated March 25, 2005 does not comply with 37 C.F.R. 1.104 as cited in MPEP 707.07. In particular, MPEP 707.07(f) requires, "Where the applicant traverses any rejection the examiner should, if he or she repeats the rejection, take notice of the applicant's argument and answer the substance of it." No notice appears to have been taken of specific arguments made with respect to claims 2, 5, 15, 16, 18 and 22. In addition, the substance of arguments made with respect to claims 1 and 10 have not been answered. MPEP 707.07(i) requires, "each pending claim should be mentioned by number and its treatment or status given." No mention of claim 26 was given. Arguments that were provided in the amendment of December 2, 2004 but not addressed in the Office Action are repeated below.

Arguments not addressed

In addition to the issues discussed in the phone interview with respect to claim 1, it is submitted that no adequate motivation to combine the teachings of Hayes and Biddle was provided in the Office Action. The Office Action stated that it would have been obvious to modify the teachings of Biddle to include the teachings of Hayes, "because this would have ensure [sic] greater security of the system." However, the Office Action did not indicate where this motivation was taught in the prior art. It is not clear how such a modification would ensure greater security than that already provided in Biddle. A *prima facie* case of obviousness requires "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," MPEP 2142. It is requested that the source of the motivation to combine these references be identified. In particular, it is requested that the portion of text in a reference that suggests this combination, or the particular knowledge of one of skill in the art be identified. Because

such motivation has not been identified, it is submitted that a *prima facie* case of obviousness has not been made.

Claims 2-5 are submitted to be allowable as depending from an allowable base claim. In addition, claims 2-5 recite claim limitations that do not appear to be shown by the cited prior art. Therefore, claims 2-5 are submitted to be additionally allowable over the cited prior art. Claim 2 includes the feature that “said e-commerce server computer and said program module server computer being distinct from one another.” These separate computers do not appear to be disclosed in the reference cited by the Office Action (fig 1, page 5 paragraphs 0053, 0054 of Biddle). With respect to Figure 1, Biddle refers to “downloading of software from a distributor computer 25 to a user computer 30 and a licensing model is executed through secure, online transactions between distributor 25 and the user 30,” paragraph 0049. Thus, it appears that both the software and licensing are handled by distributor computer 25. Biddle further states, “the vendor 40 does not have to be connected to the internet,” paragraph 0053. This appears to indicate that both software and license are available without vendor 40. Biddle also discloses, “a vendor can also assume the role of distributor 25 by purchasing a licensing system from a distributor 25 and carrying out the function of distributing software products directly,” paragraph 0053. In this example, the vendor has a “licensing system” and also distributes software products. There appears to be no disclosure of having distinct e-commerce server and program module server as in claim 2. Therefore, it is requested that the rejection be withdrawn.

Claim 5 as amended includes the limitation, “said program module is responsive to output from said licensing module, said program module and said licensing module each comprising executable software applications.” No such executable software applications appear to be shown in the cited portion of Biddle (Figure 1 and paragraphs 0056-0057). Instead, the cited portions of text appear to refer to installing software on a vendor system. This software does not appear to correspond to the licensing module of claim 5 because it is not “executed on each said customer terminal computer.” There appears to be no description in the cited portion of how the license of Biddle interacts with the software.

Claims 10-25 were rejected under 35 § USC 102 as anticipated by Biddle. Claim 10 recites, “said distribution of one said program module is responsive to the prior execution of one said licensing module on one said customer terminal computer.” This limitation was not previously identified in the prior art references. The Office Action identified “licensing server 82” as distributing license modules and identified “software” as program modules of claim 10. However, Biddle discloses adding “the software application to the electronic store (step 122) to allow users 30 to download the software application to a user computer (step 126). After downloading and installing the application, user 30 has the option of obtaining a license for the application,” paragraph 0054. Thus, it appears that Biddle first downloads the program module (software) and then a license module whereas claim 10 recites “said distribution of one said program module is responsive to the prior execution of said licensing module on one said customer terminal computer.” Because the downloading of the identified elements of Biddle is in the opposite order to that recited in claim 10, it is submitted that the rejection has been overcome. Thus, it is submitted that claim 10 as amended is allowable over the cited prior art.

Claims 15-17 are submitted to be allowable at least as depending from an allowable base claim. Claim 15 recites, “said distribution of one said program module commences automatically in response to user input to said executed licensing module.” This claim element does not appear to be shown by Biddle. In particular, Biddle does not appear to show user input to an executed licensing module. Biddle does not appear to disclose that the licensing module is separately executed or that it accepts user input. Therefore, claim 15 is submitted to be additionally allowable.

Claim 16 recites, “said program module executes in said licensed or unlicensed condition responsive to output from said licensing module.” Biddle does not appear to show this limitation because Biddle does not appear to show a program module that is responsive to output from a licensing module. Therefore, claim 16 is submitted to be additionally allowable.

Claim 18 recites, “the program module consisting of a portion of the software product that is not customized for the distributor or group of distributors, the program module comprising executable software code.” Biddle does not appear to show these

features. In particular, the element of Biddle cited in the phone interview of November 2, 2004 as corresponding to the program module, the “license” of paragraph 0054 of Biddle, does not appear to be disclosed as “comprising executable software code.” It appears that the user “obtains” a license, but the portions of Biddle cited in the Office Action (paragraphs 0055, 0058, 0059, 0062, 0065 and 0066) do not appear to disclose what type of license is obtained or whether it contains executable software code. Because the cited elements do not appear to show all the limitations of claim 18, it is submitted that claim 18 as amended is allowable over the cited portions of Biddle.

In addition, claim 18 as amended recites, “storing the configured licensing module at a first software distribution point so that it may be downloaded by a user, and storing the program module at a location other than the first software distribution point.” These features do not appear to be shown in the cited portions of Biddle and the Office Action did not indicate which features of Biddle correspond to the claim elements. Biddle states in cited paragraph 0055, “In an alternative exemplary embodiment, a vendor purchases a software licensing system (SLS).” However, it is not clear where the “software application” is stored in this example. In particular, Biddle does not appear to disclose storing the “software application” at some point other than the vendor’s distribution point. It appears that this may be an example of a vendor assuming the role of distributor, “by purchasing a licensing system from a distributor 25 and carrying out the function of distributing software products directly to the user rather than giving the software product back to the distributor for distribution,” paragraph 0053. Thus, in this scenario it appears that the vendor may become his own distributor storing software and managing licensing. In such an example the software application and license are obtained from the same location. Thus, there appears to be no storage at a location “other than the first software distribution point” of claim 18. Because this limitation has not been identified in the prior art, it is submitted that claim 18 is allowable.

Claims 19-26 are submitted to be allowable as depending from an allowable base claim. In addition, claim 22 recites, “updating the software product by modifying the program module but not modifying the licensing module.” The “license” of Biddle was identified as corresponding to the program module of claim 18 and the “software application” was identified as corresponding to the licensing module of claim 18.

However, Biddle does not appear to disclose updating the software product by modifying the license but not modifying the software application. No features of Biddle were identified as showing these claim elements.

Conclusion

Accordingly, it is believed that the present application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner is aware of any further matters that require attention, a telephone call to the undersigned attorney at (415) 318-1160 would be appreciated.

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 24, 2005.

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Respectfully submitted,

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June 24, 2005

Date